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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,496	03/26/2004	Hideyuki Shishitani	249-335 (AMK)	7877

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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

ART UNIT	PAPER NUMBER
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1732

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/809,496

Applicant(s)

SHISHITANI ET AL.

Examiner

Jeff Wollschlager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendment to the claims, specification and drawings filed January 3, 2007 has been entered. Claims 1, 2, and 5 are currently amended. The objection to the drawings and specification has been withdrawn. The 35 U.S.C. 112, second paragraph rejection of claims 1 and 3-5 has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 2, the aligning step recites that the strip form preformed product pieces are aligned into a plate shape having a front side and a back side each constituted by the cut faces and partially by the front and back faces of the strip-form preformed product pieces. The examiner notes that the different faces referenced in the claim are directed to the same faces and that it is unclear how the same faces can constitute the different surfaces as claimed. Accordingly, the scope of the claim is unclear and does not appear to be different than the scope of instant claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nippe et al. (U.S. Patent 3,819,413; issued June 25, 1974).

Regarding claims 1 and 2, Nippe et al. teach a process for producing a fuel cell component comprising: providing a conductive resin composition comprising a resin and an electrically anisotropic conductive filler (col. 2, lines 64-66; col. 3, lines 42-44); press-molding the conductive resin composition under pressure without heating to obtain a preformed product in the form of a flat plate (col. 4, lines 57-67; Figure 2a); cutting the preformed product parallel to its edge face by a predetermined width to obtain strip-form preformed product pieces having a front surface, a back surface, and a cut surface (Figure 2b); aligning the strip-form preformed product pieces so as to form as a whole a plate shape having a front surface and a back surface each constituted by the cut surfaces of the strip form preformed product pieces and by the original front and back surfaces (Figure 2c); press-forming the aligned whole preformed product pieces into a “separator shape” by welding an armor coating to hold the structure together (col. 7, lines 59-67). It is noted that the temperature required to weld an armor coating would be higher than the curing temperature of the resin. It is further noted that the claim

recitation "separator shape" is very broad. As such, it is anticipated by the Nippe et al. reference.

As to claims 3 and 4, Nippe et al. teach the anisotropic conductive filler is fibrous graphite (col. 3, lines 43-45).

As to claim 5, Nippe et al. further teach the conductive resin comprises electrically isotropic conductive filler, such as carbon black (col. 3, lines 15-18).

Response to Arguments

Applicant's arguments filed January 3, 2007 have been fully considered but are not persuasive.

Applicant's arguments appear to be on the following grounds:

1. Nippe et al. do not teach press-molding.
2. Nippe et al. do not suggest a process for molding a fuel cell.
3. Nippe et al. do not teach the limitation, "partially by the front and back faces of the strip form preformed product pieces" found in claim 2.

Applicant's arguments are not persuasive for the following reasons:

1. Nippe et al. do disclose press-molding as claimed as indicated in the rejection above and at: col. 5, lines 1-27 and col. 6, lines 13-53.
2. Nippe et al. disclose a process of producing a rechargeable electrode for storage batteries and disclose applicability to the field of fuel cells (col. 1, lines 5-35). Further, in response to applicant's arguments, the recitation "a separator for a fuel cell" has not been given patentable weight because the recitation occurs in the preamble. A

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preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The examiner notes that the body of the claim is directed to a "separator shape" and that the electrode/separator disclosed by Nippe et al. has a separator shape as claimed.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., process for molding a fuel cell) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. The examiner notes that claim 2 has been rejected under 35 U.S.C. 112, second paragraph. The aligning step recites that the strip form preformed product pieces are aligned into a plate shape having a front side and a back side each constituted by the cut faces and partially by the front and back faces of the strip-form preformed product pieces. The examiner notes that the different faces referenced in the claim are directed to the same faces and that it is unclear how the same faces can constitute the different surfaces as claimed.

Conclusion

All claims are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager
Examiner
Art Unit 1732

March 5, 2007


CHRISTINA JOHNSON
SUPERVISORY PATENT EXAMINER
3/9/07